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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,128	10/18/2005	Susumu Kobayashi	F-8789	1361

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EXAMINER	
TRAN, HANH VAN	

ART UNIT	PAPER NUMBER
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The time period for reply, if any, is set in the attached communication.

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JUN 26 2008

TECHNOLOGY CENTER 3600

Jordan and Hamburg LLP
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New York, New York 10168

In re Application of:
Susumu Kobayashi
Application No. 10/550,128
Filed: October 18, 2005
For: RAIL FIXING PART STRUCTURE

: DECISION ON PETITION
: REGARDING REQUEST
: TO WITHDRAW FINALITY

This is in response to applicant's petition, filed on March 26, 2008, to request the withdrawal of the finality of the final rejection mailed on January 28, 2008 as being improper.

The petition is **DENIED**.

Applicant alleges that the finality was improper because claim 1, as amended by the amendment filed on November 05, 2007, merely placed the claim in better form without changing the scope of the claim. In other words, the changes made in claim 1 were not substantive. Applicant alleges that by changing the language of "being resin" to "comprising resin", applicant merely made a formalistic change, not a substantive change. Similarly, other changes made in claim 1 such as changing the wording of "a flange provided at said rail" to "said rail comprising a flange", "extending" to "extends", "said metal rail fixed to said drawer" to "said metal rail is fixed to said drawer", and "ribs provided at a side surface of said drawer" to "said drawer has said ribs at a side surface of said drawer" are not substantive changes.

Applicant alleges that as the changes made in claim 1 were not made to overcome the examiners' rejection, the amendment would not necessitate a new ground of rejection. Therefore, the examiner's new rejection of claim 1 cannot be made final. As a result, the finality of the office action mailed on January 28, 2008 was improper.

A review of the application reveals that original claims 1-3 were rejected on 102(b) on Hays in the first Office action mailed on July 05, 2007. Subsequently, applicant submitted an amendment on November 05, 2007 amending claims 1-3 and adding new claims 4-10. The examiner rejected claims 1-3, and 7 on 103(a) over US patent 6,217,139 to Henriott et al. in

view of US patent 6,010,200 to Hays, and claims 4-6 and 8-10 on 102 (b) as being anticipated by US patent 6,217,139 to Henriott et al. in the final Office action mailed on January 28, 2008. On March 26, 2008 applicant filed the instant petition requesting the withdrawal of the finality of the final rejection mailed on January 28, 2008 as being improper.

In close review of the amendment dated November 05, 2007, it is noted that some changes made in claim 1 such as "extending" to "extends", and "said metal rail fixed to said drawer" to "said metal rail is fixed to said drawer" are not consider substantive changes. Applicant is correct in considering that these changes are merely formalistic in nature. However, other changes such as "being resin" to "comprising resin", "a flange provided at said rail" to "said rail comprising a flange", and "ribs provided at a side surface of said drawer" to "said drawer has said ribs at a side surface of said drawer" are clearly substantive changes. The language of "being resin" is a closed ended limitation whereas the language of "comprising resin" is an open ended limitation which is much broader in scope. The language of "a flange provided at said rail" does not require a flange to be a part of the rail whereas "said rail comprising a flange" requires a flange to be a part of the rail. As such, these changes are clearly substantive in scope. Similarly, the language of "ribs provided at a side surface of said drawer" does not required the ribs to be a part of the drawer whereas "said drawer has said ribs at a side surface of said drawer" requires the ribs to be a part of the drawer. Again, this change is clearly substantive in scope.

Taken as a whole, the amendment to claim 1 is clearly substantive in nature by changing the scope of the claim.

MPEP § 706.07(a) states that:

> "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

Since the amendment to claim 1 clearly changed the scope of the claim, it necessitates a new ground of rejection.

Based on the above facts, it is determined that the amendment filed on November 5, 2007 was substantive in scope and the changes made to claim 1 were substantive in nature. The amendment therefore necessitates a new ground of rejection. The finality of the rejection mailed on January 28, 2008 is deemed proper.

SUMMARY: The petition is DENIED.

Any questions regarding this decision should be directed to Supervisory Patent Examiner Lanna Mai at 571-272-6867.

Kathy Matecki

Kathy Matecki, Director
Technology Center 3600
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lm/tl: 5/30/08

F-8789 Ser. No. 10/550,128

Sir:

Applicant hereby petitions the Director to invoke supervisory authority pursuant to 37 CFR §1.181(a) in the above identified application to have the Examiner remove the finality of the Office Action of January 28, 2008.

MPEP § 706.07(a) states that a second or subsequent action on the merits should not be made final when the Examiner introduces a new ground of rejection that is neither necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement.

No information disclosure statement was filed after the Amendment of November 1, 2007.

The changes to claim 1 in the Amendment of November 1, 2007 were done for the purposes of placing the claim in better form and did not necessitate a new ground of rejection. However, the Office Action of January 28, 2008 rejects claim 1 as obvious over U.S. Patent No. 6,217,139 (Henriott et al.) in view of U.S. Patent No. 6,010,200 (Hays). Henriott et al. was applied for the first time in the Office Action of January 28, 2008 and was, therefore, not previously utilized by the USPTO to reject claim 1 of the present application. The amendments to claim 1 which were made in the Amendment of November 1, 2007 are below:

PAGE 2/5 * RCVD AT 3/26/2008 12:18:40 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-4/16 * DNIS:2738300 * CSID:12129537733 * DURATION (mm-ss):01-34

1. (Currently Amended) A rail fixing part structure, comprising:

a metal rail slidably supporting a drawer housed in a body, said drawer comprising ~~being~~ synthetic resin and said rail comprising a flange; and

ribs, wherein

said metal rail is fixed to said drawer[[;]],

~~a flange provided at said rail,~~ said flange extends ~~extending~~ toward said drawer; and

said drawer has said ribs ~~provided~~ at a side surface of said drawer, said ribs vertically sandwiching said flange.

The changes to claim 1 were made to place the claim in better form and were not made to overcome the Examiner's rejection. In the Amendment of November 1, 2007, Applicant submitted that Hays (which was previously cited against claim 1 by itself) did not disclose the limitation of the ribs sandwiching the flange. This limitation was present before and after the amendments to claim 1 and, therefore, the use of a new reference is improper in a final office action.

Moreover, the change of the drawer "being resin" to "comprising resin" is merely formal, not substantive, and, consequently, is not a patentable difference over Hays which states that the drawers are made of resin. The change of "a flange provided at said rail" to "said rail comprising a flange" is merely formal, not substantive, and, consequently, is not a patentable difference since the

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Examiner stated in the Office Action of July 5, 2007 that Hays disclosed a rail with a flange. Changing "extending" to "extends" and changing "said metal rail fixed to said drawer" to "said metal rail is fixed to said drawer" are merely formalistic changes. Changing "ribs provided at a side surface of said drawer" to introducing the ribs earlier in the claim and reciting "said drawer has said ribs at a side surface of said drawer" are also merely formalistic changes.

Thus, the changes to claim 1 were done for formalistic reasons and did not include any new or modified limitations that would require new art to be applied against claim 1.

Applicant's attorney contacted the Examiner to withdraw the finality of the final Office Action and the Examiner suggested that a request to withdraw the finality of the Office Action of January 28, 2008 be filed.

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Accordingly, in light of the above, Applicant respectfully requests that the finality of the Office Action dated January 28, 2008 be withdrawn.

Respectfully submitted,

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Docket No. F-8789

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Susumu KOBAYASHI
Serial No.	:	10/550,128
Filed	:	October 18, 2005
For	:	RAIL FIXING PART STRUCTURE
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Allowance Date	:	

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PETITION UNDER 37 C.F.R 1.181(a)
TO INVOKE SUPERVISORY AUTHORITY

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